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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/312,073	05/13/1999	MINORU USUI	448563/163	2072
26610	7590	10/20/2004	EXAMINER	
STROOCK & STROOCK & LAVAN LLP 180 MAIDEN LANE NEW YORK, NY 10038			NGHIEM, MICHAEL P	
			ART UNIT	PAPER NUMBER
			2863	

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/312,073

Applicant(s)

USUI ET AL.

Examiner

Michael P Nghiem

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2003 and 29 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-23,36-39,41-65,67-73,83-90,92,93,95-101,103 and 106-133 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-14,36-39,41-57,62-65,67-73,83-90,92,93,95-101,103 and 106-133 is/are allowed.
- 6) ☒ Claim(s) 15,23 and 58 is/are rejected.
- 7) ☒ Claim(s) 16-22 and 59-61 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12-22-03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The Amendments filed on December 22, 2003 and September 29, 2004 have been acknowledged.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 15, 23, and 58 are rejected under 35 U.S.C. 102(e) as being anticipated by Sasaki (US 6,270,207).

Regarding claims 15 and 58, Sasaki discloses an ink cartridge (1) for an ink jet printer (column 1, lines 13-16), comprising:

- a housing (2) having walls (2a, 2b) and an opening (top and bottom openings, Fig. 4), said housing containing ink (Fig. 19), a top wall (4, when 1 is oriented such that 4 faces upwards) of said housing being constituted by a lid (4) covering said opening of said housing (Fig. 1);

- at least one ink chamber (10) defined by said housing and said lid (Fig. 19);
- an ink supply port (15, Fig. 3) formed on one of the walls of said housing (Fig. 19);
- at least one recess (34) forming a space in an outer surface of said lid (Fig. 19) when the ink cartridge is packed under a vacuum condition (Fig. 19), the pressure within said space being lower than the atmospheric pressure when the ink cartridge is packed (column 18, lines 35-39);
- a seal member (23) adhered to the outer surface of said lid (Fig. 19),
- said recess does not communicate with an interior of the ink cartridge (34 does not communicate with chamber 9, Fig. 19), and is exposed to an exterior of the ink cartridge when the seal member is adhered to the outer surface of said lid (Fig. 19).

Regarding claim 23, Sasaki discloses an air communication hole (17) formed in said lid for communicating the interior of the ink cartridge with the atmospheric air, said air communication hole being disposed in the vicinity of said recess (Fig. 19).

Regarding claim 58, Sasaki further discloses that said ink jet printer (column 1, line 13), comprises:

- a carriage (column 1, line 15);
- a print head (column 1, lines 14-15) including a plurality of nozzles through which ink is ejected mounted on said carriage (column 1, lines 13-15);
- an ink cartridge, said ink cartridge being mounted on the carriage (column 1,

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lines 20-21).

Allowable Subject Matter

2. Claims 11-14, 36-39, 41-57, 62-65, 67-73, 83-90, 92, 93, 95-101, 103, and 106-133 are allowed.

3. Claims 16-22 and 59-61 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Reasons For Allowance

4. The combination as claimed wherein said recess is partially covered by said seal member adhered onto the outer surface of said lid (claims 16, 59) or said recess is disposed on apart of said lid which is engageable with a member of the carriage when the ink cartridge is mounted on the carriage (claims 19, 60) or a fine, circuitous groove formed in one surface of said lid where said recess is formed (claims 22, 97) is not disclosed, suggested, or made obvious by the prior art of record.

Claims 36, 57, 62, 87, 92, and 95 are allowed for reasons discussed previously.

Response to Arguments

5. Applicant's arguments filed on December 22, 2003 and September 29, 2004 have been fully considered but they are not persuasive.

With respect to the 35 USC 102 rejections, Applicants argue that nowhere does Miyazawa disclose or suggest that the lid of the ink cartridge have a recess, much less that such a recess be covered with a sealing member in a manner that allows the recess to communicate with its surroundings.

Examiner's position is that said recess be covered with a sealing member is not claimed. However, Sasaki discloses a lid (4) having a recess (34), a seal member (23) adhered to the outer surface of said lid (Fig. 19), said recess does not communicate with an interior of the ink cartridge (34 does not communicate with chamber 9, Fig. 19), and is exposed to an exterior of the ink cartridge when the seal member is adhered to the outer surface of said lid (Fig. 19).

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Contact Information

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Nghiem whose telephone number is (571) 272-2277. The examiner can normally be reached on M-H from 6:30AM – 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Barlow can be reached at (571) 272-2269. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



MICHAEL NGHIEM
PRIMARY EXAMINER
Michael Nghiem

October 15, 2004